UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/675,969 | 10/02/2003 | Hong-Ki Kim | P69161US0 | 6294 |

43569 7590 09/13/2006

MAYER, BROWN, ROWE & MAW LLP
1909 K STREET, N.W.
WASHINGTON, DC 20006

| EXAMINER | |
|---|---|
| TERMANINI, SAMIR | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2193 | |

DATE MAILED: 09/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/675,969 | KIM ET AL. | |
| | Examiner | Art Unit | |
| | Samir Termanini | 2193 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *10/02/2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-35* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-35* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *10/02/2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *12/23/04*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

## DETAILED ACTION

### *Specification*

1. The disclosure is objected to because of the following informalities:

2. The use of the trademarks "Windows 98" (para. [0003]), "Windows XP"(para. [0003], [0005]) has been noted in this application. They should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

3. On page 13 at the end of para. [0036], it appears the word "starting" is misspelled as "staring."

4. On page 13 at the end of para. [0036], it appears the label "FIG. 3B" is a typographical error and should read: "FIG. 3A", instead.

Appropriate correction is required.

### *Claim Objections*

5. **Claims 13 and 35** are objected to because periods are missing at the end of each claim. Each claim must begin with a capital letter and end with a period. Periods may not be used elsewhere in the claims except for abbreviations. *See* MPEP § 608.01(m). Appropriate correction is required.

6. **Claims 12, 13, 34, and 35** are objected to because they contain a typographical errors of the same type, namely, the limitation "vertical icon spacing" is recited twice. If applicant intended for the limitation "vertical icon spacing" to appear twice within each

respective claim, applicant is advised that the examiner will reject these claims as being indefinite under 35 USC 112 2nd Para. *See also* MPEP § 2173.05(c). Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless -
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. **Claims 1-3, 8-16, 21-25, 30-35** are rejected under 35 U.S.C. 102(b) as being anticipated by *Bogdan* (US Pat. No. 5,903,265).

As to independent **claim 1**, *Bogdan* teaches a method of controlling an icon appearance (allows a user to customize the size of window elements provided by an operating system, col. 2, lines 59-61) of a display system having a display screen (video display, col. 2, line 26), the method comprising: backing up ("During initialization of the operating system, the display driver is loaded into memory (step 30)." Col. 2, lines12-15) display properties of the display system which are currently set for an original icon appearance ("The bitmaps held in the display driver are then transferred using the BitBlt() function... to the bitmap cache...", col. 3, lines 29-32); displaying an icon control window on the display screen (dialog box 64, col. 3, lines 36-37), the icon control window including at least one sample icon for a user's preview (icon contained within preview area, preview section 68, col. 3, line 38 ;*see also* e.g. Fig. 5); changing the at least one sample icon's appearance (e.g. icon width, height, horizontal spacing, and vertical spacing VIA elements: "CXICON," "CYICON," "CXICONSPACING," and

"CYICONSPACING," respectively, see table spanning cols. 3-4) according to inputs for a new icon appearance being received from a user through the icon control window ("The user may click the mouse 44 on the upward arrow 84 to increase the element size and click the mouse on the downward arrow 86 to decrease the element size. In addition, the user may put the caret on the value and directly edit the value." col. 4, lines 44-58); and changing the icon appearance of the display system by changing the display properties in accordance with the user inputs ("after the user has finalized the changes and exited the dialog box 64, the bitmaps stored in the bitmap cache 52 (FIG. 3) are re-drawn in response to the user request...," col. 4, lines 52-55).

As to independent **claim 14,** this claim differs from claim 1 only in that, this claim is a system claim whereas claim 1 is a method claim. Since *Bogdan* taught the system for carrying out the method of claim 1 (system 36, col. 2, lines 66-67), this claim is rejected for the same reasons set forth in the treatment of claim 1.

As to independent **claim 23,** this claim differs from claim 1 only in that, this claim is a product claim defined by the method of claim 1. Since *Bogdan* taught the product for carrying out the method of claim 1 ("A computer-readable medium having computer-executable instructions for performing, by a computer system having a display and a processor running an operating system and an application program..." see Claim No. 8), this claim is rejected for the same reasons set forth in the treatment of claim 1.

As to dependent **claim 2**, *Bogdan* further teaches the limitations of claim 1 wherein the received inputs include at least one of an icon size (icon width: "CXICON" and height: "CYICON," see table spanning cols. 3-4; *see also* window element, Fig. 5) vertical icon spacing ("CYICONSPACING," see table spanning cols. 3-4; *see also* window element, Fig. 5),

horizontal icon spacing ("CXICONSPACING," see table spanning cols. 3-4; *see also* window element, Fig. 5), icon font size ("...changing the font size..." col. 6, line 7), and icon font type (icon under font selection, Fig. 5).

As to dependent **claim 3**, *Bogdan* further teaches the limitations of claim 1 wherein the icon control window comprises: an icon size controller providing a plurality of selectable icon sizes for the user to select a desired icon size from the selectable icon sizes ("pre-defined schemes that each specify a single unique set of values [through a] drop down list box 74 that lists the system metrics", col. 4, lines 10-17); a preview region including the at least one sample icon, the sample icon being resized when the desired icon size is selected through the icon size controller ("Examples of window elements that are generated in accordance with the currently selected system metrics scheme are displayed in [preview] section 68."col. 4, lines 20-22)(emphasis added); and an execution controller interfacing with the display system in order to change an icon size of the display system according to the selected icon size ("when an application program wishes to draw a window on the video display, the application program retrieves the bitmaps from the cache and uses the bitmaps to draw the system-provided window elements..." col.2, lines 16-20).

As to dependent **claim 8**, *Bogdan* further teachsthe limitations of claim 1, wherein the icon control window (e.g. 64, Fig.5) comprises: a plurality of manual input controllers (e.g. plurality of manual input controllers of control window 64, Fig. 5) manually receiving the inputs from the user ("The user may click the mouse 44 on the upward arrow 84 to increase the element size and click the mouse on the downward arrow 86 to decrease the element size. In addition, the user may put the caret on the value and directly edit the value." col. 4, lines 44-58); a preview region including the at least one sample icon, the sample icon's appearance being changed

according to the manually received inputs (section 68, col. 3, lines 36-40); and an execution controller interfacing with the display system for changing the display properties in accordance with the received user inputs ("after the user has finalized the changes and exited the dialog box 64, the bitmaps stored in the bitmap cache 52 (FIG. 3) are re-drawn in response to the user request...," col. 4, lines 52-55; see also "OK" button of 64, Fig. 5).

As to dependent **claim 9**, *Bogdan* further teachsthe limitations of claim 8, wherein the user inputs comprises at least one of an icon size (e.g. window element 70 of Fig. 5 is icon width: "CXICON" and height: "CYICON;" *see also* table spanning cols. 3-4), vertical icon spacing (e.g. window element 70 of Fig. 5 is "CYICONSPACING," *see also* table spanning cols. 3-4), horizontal spacing(e.g. window element 70 of Fig. 5 is "CXICONSPACING," *see also* table spanning cols. 3-4), icon font size ("...changing the font size..." col. 6, line 7), and icon font type (e.g. user input Fonts-> Icon in area 72 of 64 Fig. 5).

As to independent **claim 10**, *Bogdan* further teaches the limitations of claim 1, wherein the backing up display properties comprises: determining whether the display properties are valid based on a display properties table ("SystemParametersInfo(()," col. 6, lines 32-34) of the display system ("...comply with standards that permit its use in the operating system." col. 2,lines 11-12); generating a first registry subkey in a memory of the display system if the display properties are determined to be valid ("The operating system 48 provides a number of functions in the form of application programming interfaces APIs that relate to the window elements that have adjustable dimensions." Col. 5, lines 46-50); and backing up the display properties in a corresponding registry (The bitmaps held in the display driver are then transferred using the BitBlt( ) function into a cache (step 32), col. 3, lines 29-32).

As to dependent **claim 11**, *Bogdan* further teaches the limitations of claim 1, wherein the displaying an icon control window comprises: determining whether the display properties are valid ("...comply with standards that permit its use in the operating system." col. 2,lines 11-12) based on a display properties table of the display system ("SystemParametersInfo()," col. 6, lines 32-34); and displaying the icon control window on the display screen if the display properties are determined to be valid ("...by using a dialog box 64..." col. 3, lines 35-36).

As to dependent **claim 12**, as best understood, *Bogdan* further teaches the limitations of claim 1, wherein the changing the at least one sample icon's appearance comprises: determining whether the inputs for the new icon appearance are received through the icon control window ("The user may click the mouse 44 on the upward arrow 84 to increase the element size and click the mouse on the downward arrow 86 to decrease the element size. In addition, the user may put the caret on the value and directly edit the value." col. 4, lines 44-58; "...by using a dialog box 64..." col. 3, lines 35-36); and changing at least one of an icon size (icon width: "CXICON" and height: "CYICON," see table spanning cols. 3-4; *see also* window element, Fig. 5), vertical icon spacing ("CYICONSPACING," see table spanning cols. 3-4; *see also* window element, Fig. 5), horizontal icon spacing ("CXICONSPACING," see table spanning cols. 3-4; *see also* window element, Fig. 5), icon font size ("...changing the font size..." col. 6, line 7), and icon font type (icon under font selection, Fig. 5; also e.g. small cap under 72) of the at least one sample icon according to the new icon appearance if the user inputs are received through the icon control window ("...by using a dialog box 64..." col. 3, lines 35-36).

As to dependent **claim 13**, as best understood, *Bogdan* further teaches the limitations of claim 1, wherein the changing the icon appearance of the display system comprises: determining whether the inputs for the new icon appearance are supported by the display system ("...comply with standards that permit its use in the operating system." col. 2,lines 11-12); and changing at least one of an icon size (icon width: "CXICON" and height: "CYICON," see table spanning cols. 3-4; *see also* window element, Fig. 5), vertical icon spacing ("CYICONSPACING," see table spanning cols. 3-4; *see also* window element, Fig. 5), horizontal icon spacing ("CXICONSPACING," see table spanning cols. 3-4; *see also* window element, Fig. 5), icon font size ("...changing the font size..." col. 6, line 7), and icon font type (icon under font selection, Fig. 5; also e.g. small cap under 72) of the display system according to the new icon appearance if the user inputs are supported by the display system ("... and must comply with standards that permit its use in the operating system." col. 2, lines 11-12).

As to dependent **claims 15-16, 21-22**, these claims differ from claims 2-3 and 8-9, only in that, these claims are system claims whereas claims 2-3 and 8-9, respectively, are method claims. Since *Bogdan* taught the system for carrying out the method of claims 2-3 and 8-9 (system 36, col. 2, lines 66-67), these claims are rejected for the same reasons set forth in the treatment of claims 2-3 and 8-9 respectively.

As to dependent **claim 24-25 and 30-35,** these claims differ from claims 2-3 and 8-13 only in that, these claims are product claims defined by the methods of claims 2-3 and 8-13, respectively. Since *Bogdan* taught the product for carrying out the method of claim 1 ("A computer-readable medium having computer-executable instructions for performing, by a computer system having a display and a processor running an operating system and an

application program..." see Claim No. 8), these claims are rejected for the same reasons set forth in the treatment of claims 2-3 and 8-13, respectively.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10. **Claims 4-5, 17-18, and 26-27** are rejected under 35 U.S.C. 103(a) as being unpatentable over *Bogdan* in view of *Morris-Yates et al.* (US PG Pub. 2002/0054144 A1).

As to dependent **claim 4**, *Bogdan teaches* the limitations of claim 3 as discussed above. *Bogdan* does not expressly disclose that the icon size controller comprises a sliding bar with minimum and maximum icon sizes, the user selecting the desired icon size by moving a size indicator within the sliding bar. *Morris-Yates et al.* is cited for teaching the icon size controller (Fig. 3) comprising a sliding bar with minimum and maximum icon sizes (see Fig. 4 below):

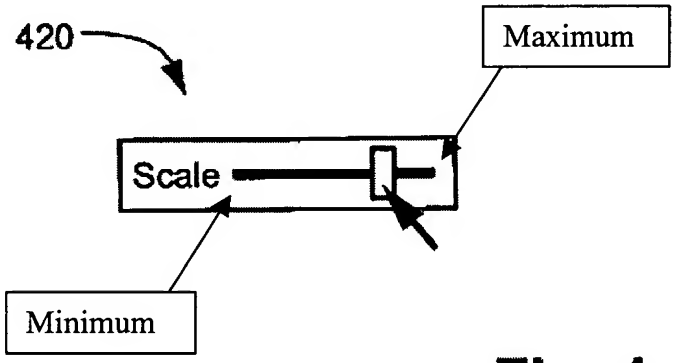



**Fig. 4**

the user selecting the desired icon size by moving a size indicator (providing active user feedback in a graphic user interface, para. [0003]) within the sliding bar (control 110 being a "scale" adjustment control in a "slider" format, para. [0006]). It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have used the sliding bar of *Morris-Yates et al.* in *Bogdan* because *Morris-Yates et al.* is directed to the same problem of using size controllers having sliding bars for scaling graphical elements and expressly suggests the use of the sliding bars for the advantage of providing "...feedback as to the potential results of changing a setting [eliminating the] "change and wait" sequence for the user, which is inconvenient and frustrating." para. [0008]).

As to dependent **claim 5**, *Bogdan* teach the limitations previously discussed with respect to claim 4 above, further comprising the minimum and maximum icon sizes of the sliding bar are selected from a size range supported by the display system ("pre-defined schemes that each specify a single unique set of values [of] system metrics", col. 4, lines 10-17). *Bogdan* does not expressly disclose that the icon size controller comprises a sliding bar with minimum and maximum icon sizes, the user selecting the desired icon size by moving a size indicator within the sliding bar. *Morris-Yates et al.* further teaches the icon size controller (Fig. 3) comprising a sliding bar with minimum and maximum icon sizes (see Fig. 4 above) the user selecting the desired icon size by moving a size indicator (providing active user feedback in a graphic user interface, para. [0003]) within the sliding bar(control 110 being a "scale" adjustment control in a "slider" format, para. [0006]). Thus, the combination of *Bogdan* and *Morris-Yates et al.* meet the claimed limitations for the same reasons set forth in the discussion of claim 4 above.

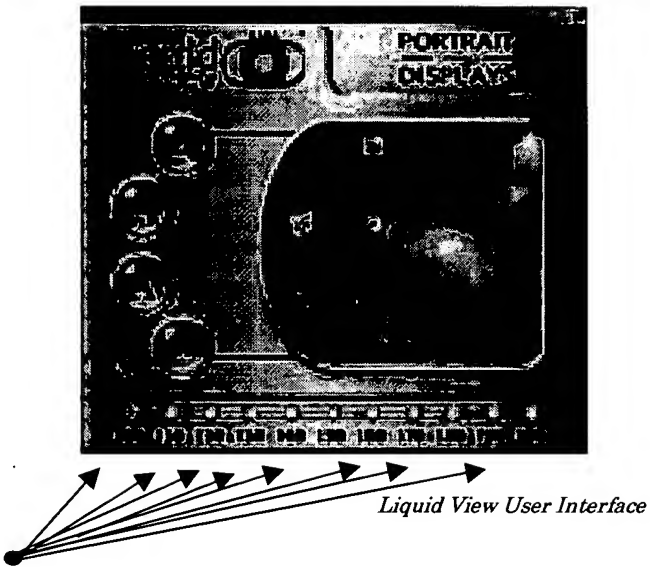
As to dependent **claims 17 and 18** these claims differ from claims 4 and 5 only in that these claims are system claims whereas claims 4 and 5, respectively, are method claims. Since *Bogdan* taught the system for carrying out the method of claims 4 and 5 (system 36, col. 2, lines 66-67), these claims are rejected for the same reasons set forth in the treatment of claims 4 and 5 respectively.

As to dependent **claims 26 and 27,** these claims differ from claims 4 and 5 only in that these claims are product claims defined by the methods of claims 4 and 5, respectively. Since *Bogdan* taught the product for carrying out the method of claim 1 ("A computer-readable medium having computer-executable instructions for performing, by a computer system having a display and a processor running an operating system and an application program..." see Claim No. 8), these claims are rejected for the same reasons set forth in the treatment of claims 4 and 5, respectively.

11. **Claims 6-7, 19-20, and 28-29** are rejected under 35 U.S.C. 103(a) as being unpatentable over *Bogdan* in view of a publication by Portrait Displays, Inc. titled "Learn How Portait Displays' Liquid View 2.0 Can Bring On-Screen Navigation Into Focus" (hereinafter "*Portrait*").

As to dependent **claim 6**, *Bogdan* teach the limitations of claim 3, discussed above. *Bogdan* does not expressly disclose the icon size controller to comprise a plurality of selectable buttons representing the plurality of selectable icon sizes, the user selecting the desired icon size by selecting one of the selectable buttons. *Portrait* is cited for teaching the icon size controller comprising a plurality of selectable buttons representing the plurality of selectable icon sizes, the user selecting the desired icon size by selecting one of the selectable buttons from 100

to 300 (Eleven predefined settings, col. 1 within text box; *See also* Fig. *Liquid View User Interface*, pp.1 below):




It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have used the selectable buttons of *Portrait* with *Bogdan* because *Portrait* is: (1) directed to precisely the same problem of controlling the display of a system having a display screen ("...which gives users an immediate way to increase the size of fonts, icons, and menus..." col. 1, second to last para.)(emphasis added); (2) is in the same field of endeavor of "...letting users quickly scale up their menus and icons..." (col. 1, last paragraph); and (3) *Portrait* expressly suggests "Liquid View 2.0 makes relationships between various user-definable elements simple and easy to change from one location."

As to dependent **claim 7**, *Bogdan* teach the limitations of claim 6 as discussed above. *Bogdan* does not expressly disclose that the plurality of selectable buttons include toggle buttons. *Portrait* is cited for teaching the plurality of selectable buttons include toggle buttons (see above, Fig. Liquid View User Interface, where each of the eleven buttons are toggle buttons). Therefore

it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have used the toggle buttons of *Portrait* with *Bogdan* for the reasons set forth above.

As to dependent **claims 19 and 20** these claims differ from claims 6 and 7 only in that, these claims are system claims whereas claims 6 and 7, respectively, are method claims. Since *Bogdan* taught the system for carrying out the method of claims 6 and 7 (system 36; col. 2, lines 66-67), these claims are rejected for the same reasons set forth in the treatment of claims 6 and 7 respectively.

As to dependent **claims 28 and 29,** these claims differ from claims 6 and 7 only in that these claims are product claims defined by the methods of claims 6 and 7, respectively. Since *Bogdan* taught the product for carrying out the method of claim 1 ("A computer-readable medium having computer-executable instructions for performing, by a computer system having a display and a processor running an operating system and an application program..." see Claim No. 8), these claims are rejected for the same reasons set forth in the treatment of claims 6 and 7, respectively.

***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

[1] Portrait Displays, Inc., LiquidView v2.0 Product Overview, 7/2/2002 for teaching

[2] *Higgins et al.* (US 5,477,241) for teaching sliding bars to resize visual elements including icons.

[3] *Eisen et al.* 1990 for demonstrating (in the year 1990) the level of skill, the recognition of the problem, and a proposed solution to dynamically changing icons either through a control menu or on the icon itself.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Samir Termanini whose telephone number is (571) 270-1047. The examiner can normally be reached on 9AM - 4PM, Monday-Friday (alternating Fridays off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chanh Nguyen can be reached on (571) 272-7772. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Samir Termanini
Patent Examiner
Art Unit 2193

/ST/

CHANH D. NGUYEN
SUPERVISORY PATENT EXAMINER